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10/726,376

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EXAMINER

MCAVOY, ELLEN M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHYUNICHI KOIDE, YASUYUKI KOMATSU, and  
MASAHIKO SHIBUYA

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Appeal 2009-005113  
Application 10/726,376  
Technology Center 1700

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Decided: December 22, 2009

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Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and  
KAREN M. HASTINGS, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1-3, 5-12, and 14-16, the only claims pending in the Application. (Appeal Brief ("Br."), filed Feb. 11, 2008, 2) We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

### STATEMENT OF THE CASE

Claim 1, the sole independent claim, is illustrative of the subject matter on appeal, and is reproduced from the Claims Appendix to the Appeal Brief:

1. A kerosene heating oil composition comprising at least 99 wt% of a) at least one n-paraffins and/or iso-paraffins, said n-paraffins and/or iso-paraffins having from 7 to 18 carbon atoms and b) at least one cyclo-paraffins and/or alkyl derivatives thereof having from 9 to 18 carbon atoms, wherein the ratio by weight of the n-paraffins and/or iso-paraffins to the cyclo- paraffins and/or alkyl derivatives thereof is from 92:8 to 25:75.

The Examiner relies on the following evidence to establish unpatentability (Examiner's Answer ("Ans."), mailed May 30, 2008, 2):

Halik	5,384,574	May 21, 1968
Kirk, Jr.	3,985,638	Oct. 12, 1976
Berlowitz	5,689,031	Nov. 18, 1997
Schreiner	5,713,964	Feb. 3, 1998

Appellants request review of the following grounds of rejection (Br. 2-3)<sup>1</sup>:

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<sup>1</sup> In the Answer, the Examiner incorrectly identifies canceled claim 4 (*see* Amendment filed May 29, 2007 (canceling claim 4)) as subject to the first ground of rejection. (Ans. 3.) Appellants incorrectly identify canceled claim 13 (*see* Amendment after Final, filed Nov. 21, 2007 (canceling claim 13); Advisory Action, mailed Nov. 21, 2007 and Ans. 2 (indicating entry of the amendment)) as subject to all four grounds of rejection. (Br. 2-5; *but see* Ans. 2 ("[A]ppellants' statement of the grounds of rejection to be reviewed on appeal is correct.")).)

1. claims 1-3, 5-9 and 14-16 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Halik;
2. claims 1-3, 5-9 and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Kirk in combination with Halik;
3. claims 1-3, 5-9 and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Schreiner in combination with Halik; and
4. claims 1-3, 5-12, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Berlowitz in combination with either Halik, Kirk or Schreiner.

Appellants' arguments are based on a limitation appearing in independent claim 1. (*See generally*, Br. 3-5; Findings of Fact, *infra*.) Appellants do not present separate arguments in support of patentability of any other claim or group of claims. Accordingly, we decide the appeal as to all four grounds of rejection on the basis of independent claim 1.

#### ISSUE

Have Appellants shown that the Examiner reversibly erred in determining that the claims are not limited to kerosene heating oil compositions, but encompass any composition that comprises the recited components in the recited amounts?

We answer this question in the negative.

#### FINDINGS OF FACT ("FF")

Appellants do not dispute the Examiner's findings that the applied prior art teaches or suggests a composition comprising the components recited in claim 1. (*See generally*, Br.) Rather, Appellants' traversal of all four grounds of rejection is based on their contention that the applied prior

art fails to disclose or suggest a “‘kerosene heating oil’ composition.” (*See* Br. 3-5.)

The terms “kerosene heating oil composition” appear in the preamble, but not in the body of independent claim 1. The preambles of the dependent claims read: “The kerosene composition.”

Appellants do not argue that the body of claim 1 does not recite the complete invention and that the preamble is necessary to give meaning to the claims. (*See generally*, Br.)

#### PRINCIPLES OF LAW

“[P]reambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). *See also*, *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005) (“Under our precedent, a preamble generally limits the claimed invention if it ‘recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.’” (quoting *Catalina Mktg.*, 289 F.3d at 808)); *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) (“[W]here a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.”).

#### ANALYSIS

Like the Examiner, we view the language in the body of claim 1 as setting out the complete invention, i.e., a composition containing various components in specified amounts. The language of the preamble states

nothing more than an intended use of the composition. Appellants have not provided arguments or evidence which establish otherwise.

Appellants have also not identified error in the facts and reasons relied on by the Examiner in establishing that the applied prior art discloses or suggests compositions containing the same components recited in the body of claim 1. Therefore, we sustain all four grounds of rejection.<sup>2</sup> *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (indicating that the burden is on appellants to demonstrate error in the Examiner's position).

### CONCLUSION

The decision of the Examiner rejecting claims 1-3, 5-12, and 14-16 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

### AFFIRMED

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<sup>2</sup> We sustain the first ground of rejection under both 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).